

REMARKS

I. Status of the Claims

Claims 47-85 are pending, with claims 61, 64, 65, 67, 68, 83, and 85¹ withdrawn, as directed to non-elected subject matter further to the Restriction Response of April 10, 2009. No claims are amended herein.

II. Rejection under 35 U.S.C. § 103(a)

The Office rejects claims 47-60, 62, 63, 66, 69-82, and 84 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0058054 to Arnaud ("Arnaud"), in view of U.S. Patent No. 4,332,738 to Benitez et al. ("Benitez"). Office Action, pages 3-5. According to the Office, Arnaud teaches "transfer-resistant cosmetic compositions comprising a variety of phases including a non-volatile silicone phase, a non-volatile hydrocarbon oil and an inert particulate phase." *Id.*, page 3. The Office contends that Arnaud teaches that its "non-volatile hydrocarbon oil may be an ester," and that "[t]he esters are preferably branched and saturated and are preferably esters of C₁₂₋₁₈ acids and C₂₋₈ polyols," but "fails to explicitly teach neopentyl glycol dineopentanoate." *Id.*, pages 3-4. The Office relies on Benitez to remedy this deficiency, in particular, the synthesis of neoesters, contending that it would have been obvious to combine the teachings of Arnaud and Benitez with a reasonable expectation of success at arriving at the instantly claimed composition. *Id.* page 4. The Office even acknowledges that Benitez "does not explicitly disclose the

¹The Examiner indicates on page 2 of the Office Action, that "[c]laim 84 has been withdrawn . . ." However, Applicant notes that claim 84 is rejected under 35 U.S.C. § 103(a) on page 3 of the Office Action. Clarification of the status of claim 84 is therefore requested.

instantly claimed species." *Id.*, pages 4-5. Applicant respectfully disagrees, and traverses the rejection based on the following reasons.

A rejection under 35 U.S.C. § 103 requires clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th ed., Rev. 6 (September 2007). The Supreme Court further emphasized this in *KSR Int'l Co. v. Teleflex*, stating that support for a § 103 rejection "should be made explicit." 127 S.Ct. 1727 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (explaining that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). Here, the Office presents defective reasons why the claimed invention would have been obvious.

Specifically, the Office's rationale for obviousness is based on two improper and conclusory reasons. The Office first argues that because Arnaud "discloses both of the individual agents required to create the instant ester," that "[a]ny person of ordinary skill in the art would have been capable of utilizing the preferred neopentaoic acid and esterifying it with the exemplified polyol, neopentyl glycol." *Id.* at page 4. Applicant respectfully disagrees.

As the Office acknowledges, Arnaud is directed to cosmetic compositions comprising non-volatile hydrocarbon oils, non-volatile silicone compounds soluble in the hydrocarbon oils, and an inert particulate phase. See Abstract. It is this particular combination of ingredients that "makes it possible to obtain a glossy deposit of very good staying power, which undergoes little or no transfer, does not migrate and is water-resistant . . ." Arnaud at ¶ [0023]. However, the Office dismisses the relevance

of the particular combination and chooses instead to focus on the non-volatile hydrocarbon oil component alone. There is nothing in Arnaud to do so. In fact, all the examples illustrate that it is the specific combination, and not one of the individual components (such as the hydrocarbon oil component under the Office's rationale) to obtain the touted benefits. Applicant notes that prior art must be considered in its entirety, including disclosures that teach away from the claims. See M.P.E.P. 2141.02 (VI). The Office fails to do so here.

In contrast with Arnaud, the presently claimed composition comprises, *inter alia*, a particular ester resulting from the reaction of a polyol and carboxylic acid. See e.g., claim 1. Applicant directs the Office to ¶ [0008] of the as-filed specification, where it states that "silicone compounds may have problems of compatibility (solubility) with other hydrocarbon-based compounds conventionally used in cosmetic compositions, which limits their use." *Id.* Applicant goes on to explain that

particular esters according to the invention have properties equivalent to those of silicone compounds while at the same time having broader compatibility (solubility) [which] allows greater diversity in formulations [and] greater harmlessness with respect to keratin materials and may thus be formulated as a supplement to or a replacement for silicone compounds.

Id. at ¶ [0010]. Thus, Arnaud, which teaches the particular combination of non-volatile hydrocarbon oils, non-volatile silicone compounds soluble in the hydrocarbon oils, and an inert particulate phase, fails to recognize that particular esters can overcome the disadvantages of silicone compounds present in combination with hydrocarbon oils.

As such, a person of ordinary skill in the art simply could not envisage Applicant's composition based on Arnaud's disclosure, as there is no suggestion in Arnaud to use

any particular ester alone without the presence of silicone compounds. Even if one of ordinary skill in the art would have instantly envisioned Arnaud's composition without the requisite silicone compounds and particulate phase, they would not look to Benitez for the particular species neopentyl glycol dineopentanoate.

The Office argues secondly that "[i]t is acknowledged that Benitez does not explicitly disclose the instantly claimed species," but that "it would have been well within the purview of the ordinary person, especially in view of Arnaud, to arrive at the instant compound." *Id.* at pages 4-5. The Office reasons that because Benitez discloses "various references . . . which are directed to the use of neoacids for use in cosmetic compositions to improve the properties thereof," that "Benitez as a whole would readily suggest to any ordinary person to use the disclosed neoacids in cosmetic compositions in order to improve the properties thereof." *Id.* Applicant respectfully disagrees.

Applicant submits that one of ordinary skill in the art would not have considered Benitez, let alone thought to combine it with Arnaud because it is non-analogous prior art. The M.P.E.P. instructs as follows:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.

M.P.E.P. § 2141.01(a)(I).

Arnaud concerns particular cosmetic compositions. See Abstract. In contrast to Arnaud, Benitez is directed to a particular esterification of neo acids using cation exchange resins, which are useful as "lubricants, lubricating oil pour point depressants and as wax crystal modifiers for lubricating oils." See Abstract; see also col. 5, ll. 34-40. The Office states that Benitez incorporates references that are directed to the use of neoacids in cosmetic compositions; however, a review of U.S. Patent Nos. 4,125,549 (directed to lubrication oils), 3,579,548 (directed to food products), and 3,590,073 (no specific utilization disclosed) does not indicate use for cosmetic compositions in these references. Nowhere does Benitez disclose or suggest that its esterification products are useful in cosmetic compositions. Rather, all of Benitez's examples demonstrate superior lubricants due to its "excellent hydrolytic stability and/or improved low temperature performance." *Id.* at col. 5, ll. 29-40. Hence, Benitez is in a field of endeavor that is totally different and unrelated to the field of endeavor of Arnaud, and, therefore would not "have commended itself to an inventor's attention in considering his or her invention as a whole."

For at least those reasons, Applicant respectfully submits that the Office failed to establish a *prima facie* case of obviousness and the rejection should be withdrawn.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and examination of the claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

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